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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,056

Applicant(s)

GAUE ET AL.

Examiner

Keith O. Robinson, Ph.D.

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendments of claims 1 and 3, the cancellation of claim 10 and the withdrawal of claims 11-20, filed December 15, 2005, have been received and entered in full.

2. Claims 11-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 15, 2005.

Claims 1-9 are under examination.

Response to Arguments

3. Applicant's arguments, see page 4 of 'Remarks', filed December 15, 2005, with respect to the objection to the specification regarding sequence listings have been fully considered and are persuasive. The objection has been withdrawn.

4. Applicant's arguments, see page 6 of 'Remarks', filed December 15, 2005, with respect to the 35 U.S.C. § 112, second paragraph rejection of claim 1 have been fully considered and are persuasive. The rejection of claim 1 is obviated by Applicant's amendment.

Applicant's remarks on page 5 of 'Remarks', filed December 15, 2005, with respect to the submission of priority documents have been fully considered and are persuasive. The objection is withdrawn.

Specification Objections

5. Applicant's arguments filed December 15, 2005 have been fully considered but they are not persuasive (see 'Remarks', page 4). Applicant argues that term "plasm" is art recognized.

This is not persuasive. As stated in the previous Office Action mailed September 12, 2005, the term "plasm" is unclear (see page 3, 2nd paragraph). Applicant seems to suggest that "plasm" and "germplasm" are interchangeable; however, in a brief search of plant breeding and genetic dictionaries and textbooks, the Examiner did not find the term "plasm". The art accepted word is "germplasm"; therefore, the Examiner maintains the objection.

Claim Rejections - 35 USC § 112, first paragraph - Enablement

6. Claims 1-9 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while enabling for the production of completely male sterile plants of *Lolium perenne* comprising mutagenizing caryopses material of *L. perenne* with the mutagenic agent N-ethyl urea ($C_3H_8N_2O$) in a concentration of 0.025% for 18 hours, does not reasonably provide enablement for a method for producing completely male sterile plants of any plant of the genus *Lolium* comprising mutagenizing caryopses

material of any plant, with any mutagenic agent, of the genus *Lolium*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicant's arguments regarding claims 1-9, filed December 15, 2005, have been fully considered but they are not persuasive. Applicant argues that a person skilled in the art is aware of numerous teachings providing concentration ranges of other mutagenizing agents apart from N-ethyl urea and how to use said agents.

This is not persuasive. Applicant alleges "numerous teachings providing concentration ranges of other mutagenizing agents apart from N-ethyl urea", but does not provide any evidence of such an allegation. In addition, though there very well may be "numerous teachings providing concentration ranges of other mutagenizing agents apart from N-ethyl urea", it would require undue experimentation for one skilled in the art determine which, if any, of such teachings would work not only with entire genus of *Lolium* plants as is broadly claimed. Applicant further argues that the use of mutagenizing chemicals for inducing particular traits is not unpredictable. The Examiner has provided evidence that the use of mutagenizing chemicals for inducing particular traits is unpredictable (see page 6, 1st paragraph of the Office Action mailed September 12, 2005). Applicant has failed to provide any evidence to overcome the Examiners rejection; therefore the rejection is maintained for reasons of record set forth in the previous Office Action mailed September 12, 2005.

Claim Rejections - 35 USC § 112, second paragraph

7. Claim 8 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant's arguments regarding claim 8, filed December 15, 2005, have been fully considered but they are not persuasive. Applicant argues that claim 8 as written is not indefinite as it does particularly point out the claimed method and distinguishes it from other methods used by Alexander.

This is not persuasive. The phrase is not a recognized art term and does not particularly point out the claimed method nor does it distinguish it from other methods used by Alexander, as stated in the previous Office Action mailed September 12, 2005 (see pages 6-7). Therefore, the Examiner maintains the rejection.

Conclusion

8. No claims are allowed.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1638

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith O. Robinson, Ph.D.

February 23, 2006

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER
